

### REMARKS

This document is filed in reply to the Office Action dated June 15, 2004 ("Office Action"). Applicants have amended claim 1 to incorporate the limitation recited in claim 2 and removed alleged new matter. This amendment has necessitated cancellation of claims 2, 21, 22, and 24-29, and dependency change to claim 3. Applicants have also cancelled claims 30 and 31, and amended claim 23 to replace "blood" recited in it with "a bone marrow aspirate." Support for this amendment can be found at, e.g., page 11, line 12 of the specification. No new matter has been introduced.

Claims 1, 3-7, 9-20, and 23 are pending. Among them, claims 12-20 have been withdrawn from further consideration for being drawn to a non-elected invention. Upon entry of the proposed amendments, claims 1, 3-7, 9-11, and 23 are under examination. Reconsideration of this application is requested in view of the following remarks:

#### Rejection under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1-7, 9-11, and 21-31 for containing new matter. See the Office Action, page 4, first paragraph. According to the Examiner, the specification does not provide support to the limitation "isolating the mesenchymal stem cells prior to cell adherence to the culture device," which was added to claim 1 in a previously filed response. Applicants have removed this limitation, and submit that this rejection has been overcome.

#### Rejection under 35 U.S.C. § 102(b)

The Examiner rejected claims 1 and 4-7 as being anticipated by U.S. Patent 5,837,539 to Caplan et al. ("Caplan"). See the Office Action, page 5, lines 8-10. Nonetheless, she acknowledged that, among others, claim 2 is free of prior art. Applicants have incorporated into independent claim 1 the limitation recited in claim 2. It is submitted that claim 1, as amended, is novel over Caplan. So are claims 4-7, all of which depend from claim 1.

• Applicant : Shih-Chieh Hung et al.  
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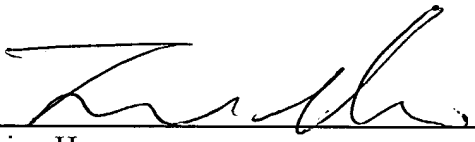
CONCLUSION

Applicants submit that grounds for the rejections asserted by the Examiner have been overcome, and that claims, as pending, define subject matter that is free of new matter and novel. Therefore, it is submitted that allowance of this application is proper, and early favorable action is solicited.

Please apply any charges to deposit account 06-1050, referencing the Attorney's Docket No. 12862-002001.

Respectfully submitted,

Date: 8-17-2004

  
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